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Mailed: 28 MAY 2003
Paper No. 10
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dewey Data LLC.

Serial No. 76/204,766

Thomas I. Rozsa of Rozsa & Chen LLP for Dewey Data LLC.

Monique C. Miller, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Simms, Hanak and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Dewey Data LLC (applicant) has filed an application to register the mark DITTODISK in typed form, for goods ultimately identified as "computer hardware and computer software which are both utilized for computer hard disk drive protection, duplication and recovery" in International Class 9.¹

¹ Serial No. 76/204,766 filed on February 1, 2001. The application is based on an allegation of a bona fide intention to use the mark in commerce.

The examining attorney² ultimately refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of the registration of the mark DITTO (in typed form) for "computer memory storage devices, namely tape drives; computer memory storage controllers; computer memory storage tape cartridges" in International Class 9.³

After the examining attorney made the refusal final, this appeal followed.

We affirm.

The examining attorney argues that "Ditto" is the dominant part of the marks and "[a]pplicant has taken the registrant's mark in its entirety and has added the descriptive term DISK to the registrant's mark." Brief at 4. The examining attorney goes on to argue that applicant has "devalued the importance of the similarities of the marks and the commercial impression retained by the average consumer." Brief at 6. Because the examining attorney found that applicant's hardware utilized for hard disk drive protection, duplication and recovery is closely

² The present examining attorney was not the original examining attorney for this application.

³ Registration No. 2,192,936 issued October 6, 1998.

related to registrant's computer memory storage devices, the examining attorney refused registration.

Applicant maintains that, while applicant's and registrant's goods are computer products, they "are clearly different." Reply Brief at 2. Applicant also cites numerous cases to show that incorporating a registrant's entire mark and adding another term to it does not automatically result in a likelihood of confusion. When the marks are viewed in their entireties, applicant concludes that its "trademark which is a single word 'DITTODISK' is totally dissimilar to the prior registrant's trademark for 'DITTO.'" Each trademark also bears its own arbitrary connotation and commercial impression." Brief at 12.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We start by comparing applicant's and registrant's marks in their entirety to determine if they are similar in sound, appearance, or meaning such that they create similar overall commercial impressions. However, "[s]ide-by-side comparison is not the test. The focus must be on the 'general recollection' reasonably produced by appellant's mark and a comparison of appellee's mark therewith." Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc., 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972) (citation omitted).

In this case, both marks contain the same word "DITTO." To this word, applicant adds the descriptive word "disk." This additional word does not significantly change the appearance, pronunciation, meaning, or commercial impression. In a similar case, the Federal Circuit held that the addition of the word "Swing" to registrant's mark "Laser" did not result in the marks being dissimilar. "[B]ecause both marks begin with 'laser,' they have consequent similarities in appearance and pronunciation. Second, the term 'swing' is both common and descriptive... Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight

in reaching a conclusion on likelihood of confusion.”
Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of “The,” “Cafe” and a diamond-shaped design to registrant’s DELTA mark still resulted in a likelihood of confusion); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). Similarly, the marks DITTO and DITTODISK are similar in sound and appearance.

We agree with the examining attorney that this additional word would be at least highly descriptive of applicant’s goods inasmuch as applicant’s goods are computer hardware and software that are “utilized for computer hard disk drive protection.” Thus, consumers would be unlikely to rely on the term “disk” in distinguishing a product designed to be used to protect disk drives.⁴

⁴ We grant the examining attorney’s request to take judicial notice of the Random House Compact Unabridged Dictionary definition of the term “disk.” University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff’d, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We decline the examining attorney’s similar invitation to take judicial notice of the definition in the Merriam-Webster’s online

The examining attorney has also submitted a dictionary definition that defines "ditto" as "a duplicate; a copy."⁵ The word DITTO used with computer memory storage devices and computer hardware and software used for, inter alia, duplication would have the same meaning, i.e., to duplicate or make a copy of a file. Therefore, these marks are similar in sound, appearance, meaning, and commercial impression.

Applicant has cited numerous case in which it was determined that there was no likelihood of confusion when an entire registered mark was combined with another term. Of course, there is no per se rule in this case and every case must be decided on its own facts. See, e.g., Colgate-Palmolive Company v. Carter-Wallace, Inc., 432 F.2d 1400, 167 USPQ 529, 530-531 (CCPA 1970) ("We are familiar with, and have considered, the array of decided cases cited and relied on by the parties. Except as the decided cases enunciate principles of trademark jurisprudence, they provide but meager assistance in the disposition of varied cases as they arise"). Certainly, as discussed earlier,

dictionary because it is not clear if there is a copy of the dictionary available in book form. In re Total Quality Group Inc., 51 USPQ2d 1474, 1475-76 (TTAB 1999); In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

⁵ *American Heritage Dictionary of the English Language* (3d ed.) (1992).

the addition of a descriptive word, such as applicant's word "disk," has often not been sufficient to avoid confusion. See Cunningham; Dixie Restaurants; and Wella Corp. The additional wording in the cases that applicant cites had a greater impact on the commercial impression of the mark. Colgate-Palmolive, 167 USPQ at 530 ("The difference in appearance and sound of the marks in issue [PEAK and PEAK PERIOD] is too obvious to render detailed discussion necessary"); Lever Brothers Co. v. Barcolene Co., 463 F.2d 1167, 174 USPQ 392 (CCPA 1972) (ALL CLEAR not confusingly similar to ALL for household cleaners).

Next, we consider whether applicant's and registrant's goods are related. "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources."

McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

Applicant's goods are computer hardware and software utilized for computer hard disk drive protection, duplication and recovery while registrant's goods are computer memory storage devices namely tape drives, controllers, and tape cartridges. Clearly, applicant's and registrant's goods are not identical, but we cannot agree that these goods are completely different as applicant argues. We must consider the goods as they are identified in the registration and applicant. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). In this case, neither applicant nor registrant limits its goods to any particular channels of trade; therefore, we must presume they move in all normal channels of trade. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages").

While there is no rule that considers all computer products to be related, Electronic Data Systems Corp. v.

EDSA Micro Corp., 23 USPQ2d 1460, 1463 (TTAB 1992) ("All computer software programs process data, but it does not necessarily follow that all computer programs are related"), applicant's and registrant's goods are sufficiently related. Applicant's hardware and software are used to protect, duplicate, and recover hard disk drives. Registrant's computer memory storage devices would include tape drives and tape cartridges that could be used to duplicate and protect files stored on a hard disk. Thus, registrant's and applicant's goods are more than simply computer hardware, they are products that could be used to accomplish the same functions, i.e., duplicating or protecting hard disk files. We agree with the examining attorney's conclusion that these goods are related. Indeed, since both applicant's and registrant's marks use the word "Ditto," meaning to duplicate or copy, the marks even suggest that the goods are used for the same purpose.

We also cannot accept applicant's unsupported argument that "the trade channels are different because the products are different and are sold to different consumers." Brief at 13. We have no reason to find that the purchasers are different. Indeed, the purchasers would appear to be the same to the extent that both applicant's and registrant's products would be sold to purchasers who need to protect or

duplicate files on their disk drives. The examining attorney has included some evidence to show that goods identified as hard disk drives and tape drives are registered by the same entities under a common mark.⁶

Applicant also refers to two applications that were originally brought to applicant's attention by the examining attorney. One, (Serial No. 75/552,077) applicant acknowledges, is abandoned. The other, Serial No. 75/686,996, applicant reports has now matured in Registration No. 2,488,461 for providing multiple user access to a global computer information network. Brief at 3. Even if this registration was properly of record, it does not support applicant's position. The services in that application are obviously significantly different from applicant's goods. Also, while third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark. In re J.M. Originals, 6 USPQ2d 1393, 1394 (TTAB 1988).

Finally, if we had any doubts regarding whether there is a likelihood of confusion, we resolve them in favor of the prior registrant and against the newcomer. In re Hyper

⁶ Registration No. 2,537,498; 2,543,799; 2,363,973; 2,443,710; and 2,2272,606.

Shoppes (Ohio) Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026
(Fed. Cir. 1988); Kenner Parker Toys v. Rose Art
Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir.
1992).

Decision: The refusal to register on the ground that
applicant's mark is confusingly similar to the mark in the
cited registration is affirmed.